

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Peter F. REILE et al.

Examiner: Omkar A. Deodhar

Serial No.: 09/977,243

Art Unit: 3714

Filed: October 16, 2001

Confirmation No.: 2235

For: **HAND-HELD ELECTRONIC TOY**

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ARGUMENTS IN SUPPORT OF PRE-APPEAL REQUEST FOR REVIEW

Applicants submit the following arguments in support of the Pre-Appeal Brief Request for Review filed herewith.

I. Independent Claims 1, 10, 19, 22, 26, 31, 32 and 43 and their respective Dependent Claims are Patentable over Hainey, Microsoft Office, Microsoft Paint and Clark.

The Examiner has rejected independent claims 1, 10, 19, 22, 26, 31, 32 and 43 under 35 U.S.C. §103(a) as being unpatentable over Hainey in view of Microsoft Office and Microsoft Paint and further in view of Clark. The Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness of each of the independent claims because the cited references do not disclose at least one element from each of the independent claims.

II. Independent Claims 1, 19, 32 and 43 and their Dependent Claims

Claim 1 recites “said second interactive tool being one of activated or inactivated based on the selection of said one of said plurality of drawing activities.” Claims 19, 32 and 43 each recite a similar recitation. The Examiner concedes that the explicit claim language of claim 1 is not taught in Hainey, but asserts that such a minor modification to Hainey’s interactive device would have been well within the level of ordinary skill in the art at the time of the invention.

The Examiner has provided no rationale or basis for this conclusory statement. (See, *KSR International Co., v. Teleflex Inc.*, 550 U.S. ___, 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385 (2007) (2007), quoting, *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” The Examiner has asserted multiple prior art references in combination and still has failed to show all of the elements recited in claim 1. Having failed to find a prior art reference to assert for the claim recitation “said second interactive tool being one of activated or inactivated based on the selection of said one of said plurality of drawing activities,” the Examiner has asserted a personal opinion that the invention recited in claim 1 is obvious, without any evidentiary support or basis in the law (see Advisory Action). This is clearly a case of impermissible hindsight in which the Examiner relies on nothing outside the Applicants’ own disclosure in reaching a conclusion of obviousness. Any legal conclusion “must be reached on the basis of the facts gleaned from the prior art.” MPEP 2142.

The hand-held device of the present application can be used for different types of drawing activities, as well as gaming activities. The tool bar is disposed on the device, and the interactive tools (although remaining displayed on the device) may or may not be activated (e.g., turned on) for use with a given activity. Characteristics associated with interactive tools can also be provided for some or all of the interactive tools by selecting an interactive tool on the toolbar. For example, if the interactive tool is activated (depending on the particular activity selected), a menu of further options or characteristics associated with that interactive tool may be displayed. If the interactive tool is inactivated (depending on the selected activity) then the further options or characteristics would not be available for use or display. Such a configuration allows for the device to be used for various activities having different functionality associated with that activity, without having to change the general appearance of the main selection screen. This provides familiarity to the user of both the appearance and functionality of a core set of interactive tools for operation of the device across varying activities. Thus, “said second interactive tool being one of activated or inactivated based on the selection of said one of said plurality of drawing activities” recited in claim 1 is a specific and unique feature of the hand-held device of the present application and is not disclosed in, suggested by or obvious in light of, the

prior art. Claims 19, 32 and 43 have similar recitations and are also non-obvious for the same reasons as stated above. Thus, the Examiner has failed to meet the burden of demonstrating a prima facie case of obviousness of claims 1, 19, 32 and 43.

III. Claim 10 and its Dependent Claims

Claim 10 recites “at least one of said plurality of interactive tools being a full screen erase tool that includes a plurality of selectable animated full-screen erase options.” The Examiner conceded in the final Office Action dated June 26, 2008, that the prior art “is silent regarding the full screen erase function having selectable animated erase options, but asserted “that it would have been obvious to one o[f] ordinary skill in the art at the time of the invention to allow users to select an animation for which to view while the system erases their screen.” The Examiner provided a screen saver as an example. The Applicants submit that the Examiner’s example of using a “screen saver” as described in the final Office Action, or a delete or edit option as described in the Advisory Action are insufficient bases to show a full screen erase tool that includes a plurality of selectable animated full-screen options as recited in claim 10. It is unclear from the Examiner’s explanation in the final Office Action and in the Advisory Action as to how the claim limitation is met. For example, a screen saver is an entirely different function than a full screen erase feature. Likewise, delete and edit functions are not the same as a full screen erase feature. Further, the examples presented by the Examiner do not provide any bases for the recitation “a plurality of selectable animated full-screen erase options.” Thus, the Examiner has failed to meet the burden of demonstrating a prima facie case of obviousness of claim 10.

IV. Claims 22 and 31 and their Dependent Claims

Claim 22 recites “retrieving a second activity application from a removable read-only memory cartridge for display on the hand-held electronic toy” and “the second characteristic being configured to interact with the retrieved second activity application from the removable read-only memory cartridge, and not the first activity application.” Claim 31 includes similar recitations.

The Examiner has again failed to show all of the elements of claims 22 and 31 in the cited prior art, but instead bases his rejection of claims 22 and 31 on conclusory statements. For example, the Examiner states in the Advisory Action that “[c]onfiguring tools to interact [and] not interact with other tools is well within the level of ordinary skill in the art . . .” The Applicants submit that claims 22 and 31 recite a unique feature of the hand-held device of the present application. Similar to the arguments above for claim 1, the device of the present application can be used for multiple different types of activities (including those provided by a removable cartridge) without changing the appearance of the main selection tool bar. The functionality (e.g., characteristics) associated with a given interactive tool can be configured to interact with some activities, but not with other activities. Thus, for a first activity (e.g., a drawing activity) provided by a first memory (e.g., from a removable cartridge or from the memory within the device), an interactive tool on the tool bar can include a characteristic that is configured to interact with the first activity. For a second activity (e.g., another drawing activity or a gaming activity) provided by a removable cartridge, the same interactive tool can have a different characteristic configured to interact with the second activity, but not the first activity. For example, a stamper interactive tool can provide a set of stamps for use with one activity that are not available for use with another activity. The Applicants submit that the Examiner’s conclusory statements fail to meet the burden of demonstrating a prima facie case of obviousness of the feature described above, as recited in claims 22 and 33.

V. Claim 26 and its Dependent Claims

Claim 26 recites “displaying a plurality of selectable starter scenes on the touch-screen display of the hand-held electronic toy based on a selection of one drawing activity from said plurality of drawing activities” and “upon receipt of a selection of a starter scene from said plurality of selectable starter scenes modifying at least one characteristic associated with an interactive tool on a toolbar from a first state to a second different state based on the selection of said starter scene.”

The Applicants submit that the Examiner’s assertion that Clark teaches selection of different starter scenes does not teach the explicit recitation in claim 26. Specifically, Clark does not teach “modifying at least one characteristic associated with an interactive tool on a toolbar

from a first state to a second different state based on the selection of said starter scene.” Merely providing a starter scene or selecting an image type as disclosed in Clark, does not meet this limitation. In the present application, multiple starter scenes are provided to the user based on a selection of an activity, and those starter scenes can vary based on the selected activity. Further, upon selection of one of the starter scenes, at least one characteristic associated with an interactive tool on the toolbar (e.g., the core toolbar described above) can be modified from a first state to a second state. For example, if a beach starter scene is selected, beach related stamps associated with the stamper interactive tool can be provided. If the starter scene is changed to a space-starter scene, the stamps associated with the stamper interactive tool will be modified to include space-related stamps. Thus, the stamp selection (e.g., characteristic) associated with the stamper interactive tool is modified from a first state (beach-related stamps) to a second state (space-related stamps) based on the selected starter scene activity. The interaction between the tool bar, the core interactive tools on the toolbar, and based on the selection of a particular activity provides specific functionality not present in the prior art. Thus, the Examiner has failed to meet the burden of demonstrating a prima facie case of obviousness of claim 26.

CONCLUSION

For the foregoing reasons, the Applicants respectfully request that the panel of Examiners review the final rejection and issue a decision that the pending claims are allowed.

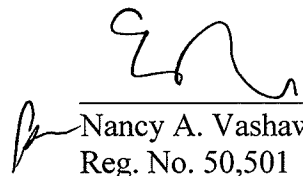
The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 50-1283.

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